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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD



03-09-2004

U.S. Patent & TMO/TM Mail Rpt Dt. #22

_____)
Geoffrey, Inc.,)
)
Opposer)
)
v.)
)
Earl Scroggin,)
)
Applicant)
_____)

Opposition No. 91157460

MOTION TO COMPEL AND TO EXTEND
THE DISCOVERY PERIOD FOR OPPOSER

Pursuant to 37 C.F.R. § 2.120(e) and TBMP § 523.01, Opposer Geoffrey, Inc. ("Opposer") hereby moves that the Trademark Trial and Appeal Board ("the Board") to compel Earl Scroggin ("Applicant") to answer, without objection, Opposer's First Set of Interrogatories and First Request for Production of Documents and to order the Applicant to file and serve an Answer to the Notice of Opposition that complies with Rule 8(b) of the Federal Rules of Civil Procedure.

"Express Mail" Mailing Label Number E5931285421 US

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514 on

3 8 04
(Date of Deposit)

Lawrence W. Greene
(Typed or printed name of person mailing paper or fee)

Lawrence W. Greene
(Signature)

As grounds for its Motion to Compel, Applicant submits that Applicant has failed to provide Opposer with a corrected Answer and to respond to Opposer's written discovery requests. Furthermore, Applicant has resisted efforts by Opposer to resolve these issues despite Opposer's repeated good faith attempts to do so. Opposer further requests that the Board suspend the proceeding pursuant to 37 C.F.R. § 2.120(e)(2), and upon deciding the motion, reset the discovery period and testimony periods by an extended three-month period. The additional time is required to permit Opposer to serve further discovery, if necessary, upon receipt and review of the Answer to the Notice of Opposition and the responses to discovery.

Background

Opposer filed a Notice of Opposition in this proceeding on July 28, 2003. After receiving Applicant's Answer on October 6, 2003, Opposer called and spoke with Applicant's counsel to inform him that the Answer was deficient insofar as it did not fully correspond to the particular claims of the Notice of Opposition. A copy of the Answer is attached as Exhibit A. Opposer requested a corrected copy of the Answer in the telephone call of October 6 as well as, subsequently, in letters, dated December 26, 2003 and February 17, 2004 and in a complete telephone message of March 3, 2004. Copies of Opposer's letters of December 26, 2003 and February 17, 2004 are attached as Exhibit B.

After the opening of discovery on September 11, 2003, Opposer served its First Request for Production of Documents and First Set of Interrogatories (collectively, the "Discovery Requests") upon Applicant, via First Class Mail, on September 29, 2003. Copies of the Discovery Requests are attached hereto as Exhibit C. Pursuant to 37 C.F.R. § 2.120 and TBMP § 403.03, responses to the Discovery Requests were due 35 days later, or no later than November 3, 2003. In the absence of Applicant's responses, Opposer requested responses to the Discovery Requests in Opposer's

aforementioned letters of December 26, 2003 and February 17, 2004 (see Exhibit B) and telephone message of March 3, 2004.

As of this date, Opposer has not received any communication regarding the Answer to the Notice of Opposition or the outstanding discovery from Applicant's counsel.

**Request for Order Compelling a Substitute Answer, Responses Without
Objection and Extension of Opposer's Discovery Period**

1. Applicant's Answer Is Deficient

The Answer filed by Applicant is set forth in paragraph form, but these paragraphs and the statements within the Answer do not fully correspond to the claims within the Notice of Opposition. Consequently, the Answer does not comply with the Federal Rules of Civil Procedure.

Rule 8(b) of the Federal Rules of Civil Procedure provides in pertinent part:

A party shall state in short and plain terms the party's defenses to each claim asserted and shall admit or deny the averments upon which the adverse party relies. If a party is without knowledge or information sufficient to form a belief as to the truth of an averment, the party shall so state and this has the effect of a denial. Denials shall fairly meet the substance of the averments denied. When a pleader intends in good faith to deny only a part or a qualification of an averment, the pleader shall specify so much of it as is true and material and shall deny only the remainder.

Rule 8(b) is made applicable to this proceeding by Trademark Rule 2.116(a). Also, 37 C.F.R. § 2.106(b)(1) provides in pertinent part that "an answer shall state in short and plain terms the Applicant's defenses to each claim asserted and shall admit or deny the averments upon which the Opposer relies." Applicant's Answer fails to admit or deny each claim.

An examination of the Notice of Opposition and Answer immediately shows that the Applicant does not admit or deny each claim asserted. The Notice of Opposition consists of 37 numbered paragraphs, whereas the Answer fails to make specific references to paragraphs 28 through

37. While some of the statements made in the Answer relate to some of the specific claims made by Opposer, the Answer is deficient insofar as it does not deal with each claim. Accordingly, Applicant should file and serve an Answer that complies with the applicable rules.

2. Applicant Has Not Responded To Discovery

Discovery Requests were served on September 29, 2003. Responses were due by November 3, 2003. No extension was requested and no responses were received.

Opposer wrote to Applicant on December 26, 2003 and February 17, 2004 requesting responses to the Discovery Requests, but no response was received. Opposer again reminded Applicant of its overdue responses by telephone message of March 3, 2004.

There are no extraordinary circumstances that excuse Applicant's failure to respond to the outstanding discovery. See TBMP § 403.03. Applicant's counsel did not contact counsel for Opposer regarding the discovery requests at the time the discovery was served or at any subsequent time.

Opposer requests that the Board order the Applicant to respond to the outstanding discovery without objection pursuant to TBMP § 403.03. Opposer also requests that the Board extend Opposer's discovery period for three months after the receipt of the Applicant's responses to discovery to permit the Opposer to review the discovery responses and conduct additional discovery.

The discovery requests were served early in this proceeding and Opposer should have additional time to conduct discovery after receiving the responses.

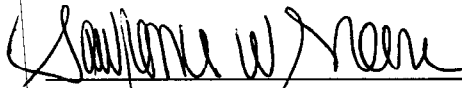
Summary

Based on Applicant's failure to provide an Answer that complies with the Federal Rules of Civil Procedure, and Applicant's failure to respond to outstanding Discovery Requests, Opposer respectfully requests that the Board order the Applicant to file a substitute Answer and respond to the outstanding Discovery Requests without objection. Opposer also requests that the discovery period for Opposer be extended for three months and the testimony dates be reset.

Respectfully submitted,

GEOFFREY, INC.

By:



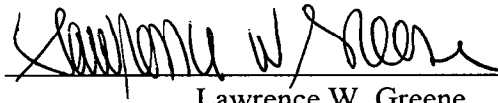
Lawrence W. Greene, Esq.
One Geoffrey Way
Wayne, NJ 07470
Tel. (973) 617-5713
Fax (973) 617-4047
Attorney for Opposer

Date: 3.8.04

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Motion to Compel and To Extend the Discovery Period for Opposer was served on Earl Scroggin, this 8th day of March, 2004, by sending same, via first class mail, postage prepaid to:

Brent A. Capehart, Esq.
Capehart Law Firm, PLLC
415 South Boston Avenue, Suite 800
Tulsa, OK 74103



Lawrence W. Greene

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Geoffrey, Inc.,)	
)	
Opposer,)	
)	
v.)	Opposition No.: 91157460
)	Serial No.: 78176812
Earl Scroggin,)	
)	
Applicant.)	
)	
)	

ANSWER TO NOTICE OF OPPOSITION

Comes now, Earl Scroggin, Applicant, and for his Answer to Notice of Opposition by Geoffrey, Inc., Opposer, does hereby state as follows:

1. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 1 of the Notice of Opposition and therefore denies the same.
2. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 2 of the Notice of Opposition and therefore denies the same.
3. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 3 of the Notice of Opposition and therefore denies the same.
4. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 4 of the Notice of Opposition and therefore denies the same.

5. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 5 of the Notice of Opposition and therefore denies the same.
6. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 6 of the Notice of Opposition and therefore denies the same.
7. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 7 of the Notice of Opposition and therefore denies the same.
8. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 8 of the Notice of Opposition and therefore denies the same.
9. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 9 of the Notice of Opposition and therefore denies the same.
10. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 10 of the Notice of Opposition and therefore denies the same.
11. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 11 of the Notice of Opposition and therefore denies the same.

12. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 12 of the Notice of Opposition and therefore denies the same.
13. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 13 of the Notice of Opposition and therefore denies the same.
14. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 14 of the Notice of Opposition and therefore denies the same.
15. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 15 of the Notice of Opposition and therefore denies the same.
16. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 16 of the Notice of Opposition and therefore denies the same.
17. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 17 of the Notice of Opposition and therefore denies the same.
18. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 18 of the Notice of Opposition and therefore denies the same.

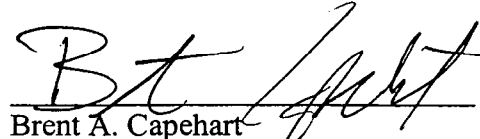
19. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 19 of the Notice of Opposition and therefore denies the same.
20. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 20 of the Notice of Opposition and therefore denies the same.
21. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 21 of the Notice of Opposition and therefore denies the same.
22. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 22 of the Notice of Opposition and therefore denies the same.
23. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 23 of the Notice of Opposition and therefore denies the same.
24. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 24 of the Notice of Opposition and therefore denies the same.
25. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 25 of the Notice of Opposition and therefore denies the same.

26. The applicant is without knowledge or information sufficient to form a belief as to the truth of the averments and allegations contained in paragraph 26 of the Notice of Opposition and therefore denies the same.
27. Applicant admits the allegations and averments contained in paragraph 27 of the Notice of Opposition.
28. Applicant denies the allegations and averments contained in paragraph 27 of the Notice of Opposition.
29. Applicant denies the allegations and averments contained in paragraph 27 of the Notice of Opposition.
30. Applicant denies the allegations and averments contained in paragraph 27 of the Notice of Opposition.
31. Applicant denies the allegations and averments contained in paragraph 27 of the Notice of Opposition.
32. Applicant denies the allegations and averments contained in paragraph 27 of the Notice of Opposition.
33. Applicant denies the allegations and averments contained in paragraph 27 of the Notice of Opposition.
34. Applicant denies the allegations and averments contained in paragraph 27 of the Notice of Opposition.
35. Applicant denies the allegations and averments contained in paragraph 27 of the Notice of Opposition.
36. Applicant denies the allegations and averments contained in paragraph 27 of the Notice of Opposition.

37. Applicant denies the allegations and averments contained in paragraph 27 of the Notice of Opposition.

WHEREFORE, Applicant prays this Opposition be denied.

Respectfully submitted,




Brent A. Capehart
Capehart Law Firm, PLLC
P.O. Box 4126
Tulsa, Oklahoma 74159-0126
(918) 640-8222
(918) 749-8955 (fax)
bcapehart@capehartlaw.com

*ATTORNEY FOR APPLICANT,
EARL SCROGGIN.*

CERTIFICATE OF MAILING

I hereby certify that on this 30th day of September, 2003, a true and correct copy of the above and foregoing document was mailed via Express Mail, No. ER310767603US to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 and with proper postage as first-class mail to: Lawrence W. Greene, Attorney for Opposer, 461 From Road, Paramus, New Jersey 07652, (201) 576-9360, (201) 576-9362 (fax)



Brent A. Capehart

Geoffrey, Inc.

December 26, 2003

Via First Class Mail

Brent A. Capehart, Esq.
Capehart Law Firm, PLLC
415 South Boston Avenue, Suite 800
Tulsa OK 74103

Re: *Geoffrey, Inc. v. Earl Scroggin*
Opposition to U.S. Application Serial No. 78/176,812 for
OFFICESUPPLIESRUS

Dear Mr. Capehart:

As you know, in our telephone conversation of October 15, 2003, we discussed the above-referenced opposition. Specifically, we requested a corrected Answer insofar as the Answer made an erroneous paragraph reference in the answers to Paragraphs 28 through 37 of the Notice of Opposition. At the same time, you indicated you would confer with your client about his interest in pursuing his application given the extent of Geoffrey, Inc.'s rights in the "R" US mark. You indicated that, thereafter, you would contact me.

At this date, I have not yet heard from you. Please advise me of your client's intentions in this matter, so that we may proceed accordingly. We also wish to inform you that your client is now overdue in responding to document requests and interrogatories that were served upon you, by mail, on September 29, 2003. As you know, your client was obligated to provide us with responses no later than 35 days after September 29, 2003. See 37 CFR § 2.120(a); TBMP § 403.03.

In the event your client wishes to proceed with its application, we look forward to receiving the corrected Answer and aforementioned responses to our discovery requests. Please let me know if you have any questions or if you wish to further discuss this matter.

Sincerely,



Lawrence Greene

15497-1

Geoffrey, Inc.

February 17, 2004

Via First Class Mail

Brent A. Capehart, Esq.
Capehart Law Firm, PLLC
415 South Boston Avenue, Suite 800
Tulsa OK 74103

Re: *Geoffrey, Inc. v. Earl Scroggin*
Opposition to U.S. Application Serial No. 78/176,812 for
OFFICESUPPLIESRUS

Dear Mr. Capehart:

Further to my letter of December 26, 2003, to which I received no response, I again inquire about your client's intentions concerning the above-referenced application. As you know, in my December letter we requested a correction in the Answer that you filed with the TTAB, to reflect answers to Paragraphs 28 through 37 of the Notice of Opposition. We also requested responses to the document requests and interrogatories that were served upon you, by mail, on September 29, 2003. Responses were due 35 days from the date of mailed service.

Because the Discovery period is scheduled to close on **March 9, 2004**, the need to the corrected Answer and discovery responses is urgent.

I look forward to hearing from you.

Sincerely,



Lawrence Greene

16735-1

INTERROGATORY NO. 4

Identify representative copies of all advertising or promotional materials such as tags, labels, posters, flyers, advertisements, catalogs, brochures, business cards and signs which have ever been used by Applicant in connection with the services offered under the Applicant's Mark.

INTERROGATORY NO. 5

State whether a trademark search or any other type of search was conducted by Applicant in connection with his adoption, use or application for registration of Applicant's Mark. If so, identify all documents relating and/or referring to such search(es) and identify the person(s) most knowledgeable thereof. Furthermore, identify all references disclosed by such search(es).

INTERROGATORY NO. 6

Identify by publication, title, issue date and page number, all written or electronic publications from whatever source in which Applicant advertised or otherwise referred to services offered for sale and/or rendered in association with the Applicant's Mark.

INTERROGATORY NO. 7

Identify all objections made or received by Applicant and all legal proceedings instituted or defended by Applicant concerning use of trade names, trademarks, service marks or other designations of third parties relating to Applicant's perceived rights in Applicant's Mark and for each such objection or legal proceeding:

- a) state the name and address of the third party; and
- b) identify all documents relating and/or referring to the objection or legal proceeding.

INTERROGATORY NO. 8

Identify all agreements, including but not limited to, licenses, permissions or consents entered into by Applicant and any other entities relating to the Applicant's Mark and identify all documents relating and/or referring to each such agreement.

INTERROGATORY NO. 9

Identify all trade shows where Applicant's services are promoted under Applicant's Mark.

INTERROGATORY NO. 10

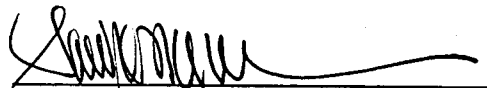
Identify each and every person known by Applicant to have supplied information for or participated in responding to these interrogatories and Opposer's First Requests for Production of Documents to Applicant.

Respectfully submitted,

GEOFFREY, INC.

Date: September 19, 2003

By:



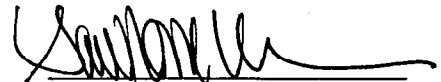
Lawrence W. Greene, Esq.
One Geoffrey Way
Wayne, New Jersey 07470
(973) 617-5713
Fax: (973) 617-4047

Attorney for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT was served on this 29th day of September, 2003, by sending same, via first class mail, postage prepaid to:

Brent A. Capehart
Capehart Law Firm, PLLC
1417 East 20th Street
Tulsa, OK 74120


Lawrence W. Greene